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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196926
Party	Defendant Dorfman-Pacific Co.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GMA ACCESSORIES, INC.,	)	
	)	
Opposer,	)	Opposition No.:91196926
	)	
v.	)	Application No.: 77/965,616
	)	
DORFMAN-PACIFIC CO.,	)	Mark: CAPPELLI STRAWORLD
	)	
<u>Applicant.</u>	)	

**ANSWER AND COUNTERCLAIM**

Applicant Dorfman-Pacific Co. hereby answers Opposer GMA Accessorites, Inc.’s  
Notice of Opposition as follows:

1. Applicant admits that Opposer alleges it is “current title owner” of certain  
“Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 1  
of Opposer’s Notice of Opposition.

2. Applicant admits that Opposer alleges it is “current title owner” of certain  
“Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 2  
of Opposer’s Notice of Opposition.

3. Applicant admits that Opposer alleges it is “current title owner” of certain  
“Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 3

of Opposer's Notice of Opposition.

4. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 4 of Opposer's Notice of Opposition.

5. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 5 of Opposer's Notice of Opposition.

6. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 6 of Opposer's Notice of Opposition.

7. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 7 of Opposer's Notice of Opposition.

8. Denied.

9. Denied. It is unclear to Applicant which "mark" Opposer refers to in paragraph 9 of Opposer's Notice of Opposition, especially in view of Applicant's long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 9 of Opposer's Notice of Opposition as vague and ambiguous.

10. Denied.

11. Applicant lacks sufficient information to determine the truth or falsity of the allegations contained in paragraph 11 of the Notice of Opposition and, therefore, Applicant

denies the allegations contained in paragraph 11 of the Notice of Opposition.

12. Denied. It is unclear to Applicant what “senior user” Opposer refers to in paragraph 12 of Opposer’s Notice of Opposition, especially in view of Applicant’s long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 12 of Opposer’s Notice of Opposition as vague and ambiguous.

13. Denied. It is unclear to Applicant what “DORFMAN-PACIFIC’s date of first use” refers to in paragraph 13 of Opposer’s Notice of Opposition, especially in view of Applicant’s long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 13 of Opposer’s Notice of Opposition as vague and ambiguous.

14. Denied.

15. Denied. *In re E.I.Dupont de Nemurs, & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563(CCPA 1973), requires an analysis of several factors in determining whether or not a likelihood of confusion exists in a specific situation, it is not limited to “appearance, sound, connotation and commercial impression” as alleged in paragraph 15 of Opposer’s Notice of Opposition.

16. Denied. Determining whether or not a likelihood of confusion exists in a specific situation requires an analysis of several factors and the determination is not limited to an assessment of “the inclusion of additional words, prefixes or suffixes” as alleged in paragraph 16 of Opposer’s Notice of Opposition.

17. Denied. Determining whether or not a likelihood of confusion exists in a specific

situation requires an analysis of several factors and the determination is not limited to an assessment of “the goods or services” as alleged in paragraph 17 of Opposer’s Notice of Opposition.

18. Denied. Determining whether or not a likelihood of confusion exists in a specific situation requires an analysis of several factors and the determination is not limited to an assessment of whether the goods “are related in some manner” as alleged in paragraph 18 of Opposer’s Notice of Opposition.

19. Denied.

20. Denied.

21. Denied. Any such alleged “likelihood of confusion ... and dilution”, as alleged in paragraph 21 of Opposer’s Notice of Opposition, should result in the cancellation of registrations pled by Opposer in Opposer’s Notice of Opposition as set forth below in Applicant’s Counterclaims For Cancellation.

22. Admitted.

23. It is unclear to Applicant what specific meaning Opposer ascribes to the words “successor in interest” in paragraph 23 of Opposer’s Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 23 of Opposer’s Notice of Opposition as vague and ambiguous.

24. It is unclear to Applicant what specific meaning Opposer ascribes to the words “in privity with” in paragraph 24 of Opposer’s Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 24 of Opposer’s Notice of Opposition as vague and ambiguous.

25. Denied.

26. Denied. Cancellation No. 92044972 was never determined on the substantive merits. It terminated on the basis of a procedural matter relating to discovery issues and has no preclusive effect with respect to the present proceedings.

27. It is unclear to Applicant whether Opposer is referring to the undersigned counsel in these proceedings, i.e. Zimmerman & Cronen, LLP, or to counsel for the registrant in Cancellation No. 92044972, i.e. Charles J. Prescott, P.A., in paragraph 27 of Opposer's Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 27 of Opposer's Notice of Opposition as vague and ambiguous. However, the information relating to the identity of counsel of record and applicant information is publicly available information that may be found on the Trademark Office website, <[www.uspto.gov](http://www.uspto.gov)>.

28. Denied. In an Order dated August 28, 2006, in Cancellation No. 92044972, the Trademark Trial and Appeal Board "granted" the "Petitioner's motion for discovery sanctions", stating that "Registration No. 2670642 will be cancelled in due course." (Emphasis added).

29. Denied.

30. Denied.

31. Denied.

32. Denied.

### **AFFIRMATIVE DEFENSES**

#### **FIRST AFFIRMATIVE DEFENSE**

1. As a first and separate defense to Opposer's Notice of Opposition, Applicant alleges

that Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

### **SECOND AFFIRMATIVE DEFENSE**

2. As a second and separate defense to Opposer's Notice of Opposition, Applicant alleges that there is no reasonable dispute that Applicant has not infringed upon any valid rights of Opposer and that, therefore, there is no evidence to support Opposer's claims for relief in this matter.

### **THIRD AFFIRMATIVE DEFENSE**

3. As a third and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer's claims are barred by the doctrine of unclean hands and/or fraud on the Trademark Office.

### **FOURTH AFFIRMATIVE DEFENSE**

4. As a fourth and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer's claims are barred by the doctrines of laches, acquiescence, and estoppel.

### **FIFTH AFFIRMATIVE DEFENSE**

5. As a fifth and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer lacks standing to file this opposition proceeding.

### **COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S TRADEMARK REGISTRATIONS**

1. Opposer hereby incorporates by reference the facts and information set forth above in numbered paragraphs 1 through 32 and in Opposer's First through Fifth Affirmative Defenses, in Opposer's Counterclaim for Cancellation of Opposer's alleged Trademark Registrations, as set

forth herein.

2. Opposer's Notice of Opposition alleges that Opposer is "current title owner" of the following United States Trademark Registration Nos.: 3,241,182; 3,241,184; 3,246,017; 3,248,875; 3,258,734; 3,273,451; 3,322,312, for the designation "CAPELLI".

3. Opposer's alleged registered mark is merely descriptive in that said designation is an apt and common term used to describe goods of the nature described in said registrations.

4. Opposer is not entitled to exclusive use of the designation in Opposer's alleged trademark registrations, and Opposer's alleged mark does not function to identify Opposer's goods and distinguish them from those offered by others.

5. Opposer's alleged registrations are for the common descriptive name of articles included in Opposer's description of goods and has become the generic name of such goods. Applicant is likely to be damaged by Opposer's registrations of said generic term as this tends to impair Applicant's right to legal use of said term.

6. Opposer abandoned said registered marks by discontinuing use of said marks in connection with the goods recited therein which tends to impair Applicant's right to use and register its mark.

7. Opposer's registrations were obtained fraudulently in that the formal application papers filed by Opposer stated that the registered mark was being used in association with goods offered by Opposer when, in fact, upon information and belief, Opposer's registered marks were not being used in association with such goods. Upon information and belief, said knowingly false representation was made by an authorized agent of Opposer with the intent to induce authorized agents of the U.S. Trademark Office to grant such registrations, and, reasonably



relying upon the truth of said false statements, the U.S. Trademark Office did, in fact, grant said registrations. Applicant was damaged by said false statements and the registrations issued in reliance thereon, and Applicant's continued and legal use of its said mark will be impaired by the continued registrations of the alleged mark of Opposer.

WHEREFORE, Applicant prays United States Trademark Registration Nos. 3,241,182; 3,241,184; 3,246,017; 3,248,875; 3,258,734; 3,273,451; and 3,322,312 be cancelled and that this Counterclaim For Cancellation be sustained in favor of Applicant.

Respectfully submitted,

Dated: November 23, 2010

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